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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/768,178	01/24/2001	Toshihiro Shoji	010055	9209

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EXAMINER	
FERGUSON, LAWRENCE D	

ART UNIT	PAPER NUMBER
1774	16

DATE MAILED: 10/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/768,178	SHOJI, TOSHIHIRO
	Examiner	Art Unit
	Lawrence D Ferguson	1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *04 August 2003* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *5 and 9* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *5 and 9* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Response to Amendment

1. This action is in response to the amendment mailed August 8, 2003. Claims 6-8 were canceled and claims 5 and 9 were amended, rendering claims 5 and 9 pending.

Claim Rejections – 35 USC 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 5 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. In Claim 5, the phrase, 'wherein the pH value of a 1 wt% methanol solution of the ultraviolet curable composition is within the range of 4.5 to 6.8' is unclear and indefinite. It is unclear how the pH value ties into the ultraviolet-curable composition because it is not directed to any of the films. Additionally, Examiner is unclear as to what the composition actually is. Applicant clarifies the optical recording medium; however, fails to define the ultraviolet-curable composition.

Claim Rejections – 35 USC § 103(a)

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 5 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki et al. (U.S. 5,573,831).

Suzuki discloses an optical recording medium comprising a substrate, recording layer, reflective layer and protective layer where the protective layer is formed of an ultraviolet curable resin (abstract and column 2, lines 31-37) where the reflective layer contains metals such as Ag (column 3, line 67 through column 4, line 1). Although Suzuki does not disclose films, per se, layers are analogous to films. Suzuki does not show that the ultraviolet curable composition has a pH value as in instant claim 5. However, such pH is a property which can be easily determined by one of ordinary skill in the art. With regard to the limitation of the pH, absent a showing of unexpected results, it is obvious to modify the conditions of a composition because they are merely the result of routine experimentation. The experimental modification of prior art in order to optimize operation conditions (e.g. pH) fails to render claims patentable in the absence of unexpected results. The aforementioned limitation is optimizable as it directly affects the stability of the composition. As such, it is optimizable. It would have been obvious to one of ordinary skill in the art to make the ultraviolet composition with

the limitation of the weight percent since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 USPQ 215 (CCPA 1980). In instant claim 9, Applicant amends to include the claim language 'formed by curing the ultraviolet-curable composition.' The phrase, 'formed by curing the ultraviolet-curable composition,' introduces a process limitation to the product claim. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966. Further, process limitations are given no patentable weight in product claims. Additionally, the phrase, used for a protective film, in instant claim 5 is held to be intended use. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See In re Casey, 152 USPQ 235 (CCPA 1967) and In re Otto, 136 USPQ 458, 459 (CCPA 1963).

Claim Rejections – 35 USC § 103(a)

6. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gaske et al. (U.S. 4,127,460).

Gaske teaches an ultraviolet curable aqueous emulsion composition having a pH in the range of 5.0 to 8.5 (claim 1). Gaske teaches various alcohols can be utilized with the composition (column 5, lines 45-55). The phrase, used for a protective film, in instant claim 5 is held to be intended use. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See In re Casey, 152 USPQ 235 (CCPA 1967) and In re Otto, 136 USPQ 458, 459 (CCPA 1963).

Response to Arguments

7. Rejection made under 35 USC 112, second paragraph, is upheld due to a lack of clarification. Although Applicant incorporates 'ultraviolet curable' into the phrase, the phrase remains unclear to one of ordinary skill in the art. Furthermore, it is unclear as to what the composition actually is. Applicant clarifies the optical recording medium; however, fails to define the ultraviolet-curable composition.

Arguments regarding rejection made under 35 U.S.C. 103(a) as being unpatentable over Suzuki et al. (U.S. 5,573,831) have been considered but are unpersuasive. Applicant argues Suzuki does not disclose a concept of controlling pH value of a composition for protective film. With regard to the limitation of the pH, absent a showing of unexpected results, it is obvious to modify the conditions of a composition

because they are merely the result of routine experimentation. The experimental modification of prior art in order to optimize operation conditions (e.g. pH) fails to render claims patentable in the absence of unexpected results. Applicant further argues Suzuki does not teach controlling a pH value to improve durability. Improving durability is considered an intended use, which is given little patentable weight. Applicant argues Suzuki does not disclose the weight percent of the carboxyl group. Applicant no longer claims weight percentage of a carboxyl group. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., weight percentage of carboxyl group) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is (703) 305-9978. The examiner can normally be reached on Monday through Friday 8:30 AM – 4:30PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on (703) 308-0449. Please allow the examiner twenty-four hours to return your call.

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2351.

LDF

Lawrence D. Ferguson
Examiner
Art Unit 1774